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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/992,232	11/06/2001	Carl C. Awh	54084-8682	5474

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EXAMINER

THALER, MICHAEL H

ART UNIT PAPER NUMBER

3731

DATE MAILED: 02/27/2004

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/992,232

Applicant(s)

AWH ET AL.

Examiner

Michael Thaler

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3,5,7.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

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The disclosure is objected to because of the following informalities: Reference numeral 46 is absent from the drawings. Further, no bore is seen in the drawings. Reference numeral 48, cited on page 8, line 25 of the specification, does not denote a hole in figure 6. Appropriate correction is required.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the interior bore defined in claim 7, for example, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 2 and 4 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the

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art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It is unclear what the structure of the alternative embodiment described on page 8, lines 22-24 is and how one would construct it. In the embodiment shown in figures 3-7, finger pad 26 is secured to the exterior of sleeve 20 while the optic fiber is inside of sleeve 20. In the alternative embodiment described on page 8, lines 22-24, it is unclear how finger pad 26 could reach the optic fiber to be attached to it since sleeve 20 is between finger pad 26 and sleeve 20 and thus would interfere with such attachment.

Claim 11 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. There is no antecedent basis for "the plastic".

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4 and 7-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Loeb (2002/0193781). Loeb discloses

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handle 14, tubular sleeve 2 and optical fiber 6 having an adjustable bend therein (since it is fixed within cannula 4 which has a preformed bend). Loeb fails to disclose that the optical fiber 6 is plastic. However, it is old and well known in this art to use plastic as the material for optical fibers since it is durable, flexible and relatively inexpensive. It would have been obvious to use plastic as the material for the Loeb optical fiber 6 so that it too would have these advantages. As to claim 4, the distal end portion of optical fiber 6 has a preformed bend since it is fixed within cannula 4 which has a preformed bend. As to claim 7, Loeb fails to disclose an interior bore in optical fiber 6. However, it is old and well known in this art to include a bore in optical fibers since it is permits fluid to be inserted or removed from the body therethrough. It would have been obvious to include a bore in the Loeb optical fiber 6 so that it too would have this advantage. As to claim 13, Loeb discloses a layer of sliding material 64.

Claims 5, 6, 17 and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Loeb (2002/0193781) in view of Esch et al. (5,469,524). Loeb fails to disclose the handle 14 having a mechanism connected to the sleeve 2 to move it. However, Esch et al. teach that a handle 37 should have a

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mechanism 41 connected to a sleeve 45 which surrounds an optic fiber 53 in order to retract or extend the sleeve relative to the optic fiber apparently so that sleeve 45 may be conveniently retracted or extended (col. 2, line 53 to col. 3, line 15). It would have been obvious to include such a mechanism on the Loeb handle so that it too would have this advantage.

Claims 15, 16, 18 and 22-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Esch et al. (5,469,524). Esch et al. disclose handle 37, tubular sleeve 37, optical fiber 53 and mechanism 41. Esch et al. fail to disclose that the optical fiber 53 is plastic. However, it is old and well known in this art to use plastic as the material for optical fibers since it is durable, flexible and relatively inexpensive. It would have been obvious to use plastic as the material for the Esch et al. optical fiber 53 so that it too would have these advantages.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Note col. 6, lines 14-18 of Gough et al. (5,735,847).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Thaler whose telephone number is (703) 308-2981. The examiner can normally be reached Monday to Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael J. Milano can be reached on (703)308-2496. The fax phone number for the organization where this application or proceeding is assigned is (703)872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0858.

mht
2/19/04



MICHAEL THALER
PRIMARY EXAMINER
ART UNIT 3731